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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,701	05/16/2001	Benjamin P. Warner	S-94,661	4132

7590 02/20/2003

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EXAMINER

DAVIS, DEBORAH A

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,701

Applicant(s)

WARNER ET AL.

Examiner

Deborah A Davis

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Sequence Letter*.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The specification contains sequence disclosures (see pages 5 and 8) that are by definition for nucleotide and/or amino acid sequences. Therefore, this application is not in sequence compliance (see attached sequence letter).

Appropriate action is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pirrung et al (WO 90/15070).

Pirrung et al teaches a method and device for preparing desired sequences on a substrate at known locations wherein bound material of the substrate is exposed to irradiation (pg. 10, lines 1-35) so as to activate material and permit binding (see abstract). The substrate has a variety of uses such as screening large numbers of peptides or receptors, wherein receptors are labeled

Art Unit: 1641

with fluorescent markers for detection. Other applications of the invention include doping of organic material in the substrate (pg. 5, lines 14-36). In an alternative embodiment the surface may comprise of cage binding members that are capable of immobilizing receptors in predefined regions of a substrate for selective activation that allow receptors that have differential affinity for one or more ligands to react (pg. 55, lines 30-37 and pg. 56, lines 1-11). A specific binding substance having a strong binding affinity for the binding member and a strong affinity for the receptor or a conjugate of the receptor may be used to act as a bridge between binding members and receptors if desired. The method uses a receptor prepared such that the receptor retains its activity toward a particular ligand (pg. 56 lines 30-36). According Pirrung et al, receptors used in this method could be organic compounds such as polymers (oligomer), nucleic acids, peptides, drugs, cellular membranes, cells, etc. (pg. 11, lines 7-24). The binder molecule can be selected from the group consisting of agonists and antagonists for cell membrane receptors, oligonucleotides, nucleic acids, proteins, antibodies, etc. (pg. 9, lines 30-37).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1641

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pirrung et al in view of Weinberg et al (USP#6,030,917).

The teachings of Pirrung et al are set forth and is silent with respect to the binder being a metal ion.

However, Weinberg et al teaches methods of screening and characterization of libraries of organonometallic compounds which can be used as catalysts and therapeutic agents (see abstract). Ancillary ligand-stabilized metal complexes are also useful as catalysts for reactions such as oxidation, reduction, hydrogenation, polymerization, carbonylation and other reactions.

It would have been obvious to one of ordinary skill in the art to use the metal ion binder of Weinberg et al in the method and device for preparing desired sequences on a substrate as taught by Pirrung et al to screen for therapeutic agents and catalysts that are useful in oxidation, reduction and other useful reactions.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

A. Pirrung et al (USP#5,143,854) discloses a method for performing large scale photolithographic solid phase synthesis of polypeptides and receptor binding screening thereof.

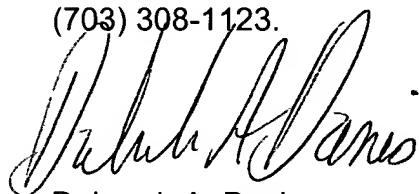
B. Blumberg et al (USP#6,274,321) disclose methods for screening cDNAs.

Art Unit: 1641

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A Davis whose telephone number is (703) 308-4427. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.



Deborah A. Davis
CM1, 7D16
January 31, 2003



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

2/2/03